UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
RODRIGUEZ, LENNIN R

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
07/22/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2008*.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,12,13,17 and 18* is/are pending in the application.
  4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1,12,13,17 and 18* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  a)☒ All   b)☐ Some * c)☐ None of:
    1.☒ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
  Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
  Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments, see Appeal Brief, filed on 5/13/2008, with respect to the rejection(s) of claim(s) 1, 12 and 16-18 under 35 U.S.C. 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Rhoads et al. (US 2002/0176116).

Claim Rejections - 35 USC § 103

2.   The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3.   Claims 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Desormeaux (US 6,312,124) in view of Yamada (US 5,927,872) and Rhoads et al. (US 2002/0176116).

Desormeaux '124 discloses a hybrid printing device for printing on a surface (Fig. 1 and Fig. 2 and column 7, lines 4-23, where in addition to a printing component the device can also contain an optical sensor), the device comprising:

a printing means adapted to print on the surface (column 2, lines 66-67 and column 3, lines 1-8); and

a sensing means adapted to sense the position of the printing device in relation to positioning indicia located on the surface wherein the printing means is further

adapted to be responsive to the detected position of the device in relation to the detected position (column 7, lines 4-23, where the device can contain an optical sensor which detects indicia on a surface and responds to this indicia as to what operation to perform).

wherein the positioning indicia encode data describing absolute or relative positions on the surface, said indicia being optically imaged by the sensing means and thus providing an output representing the absolute position of the printing means on the surface (column 7, lines 4-23, where the device can contain an optical sensor which detects indicia on a surface and where the indicia served as an optical pattern to generate a positional feedback signal).

Desormeaux '124 discloses all the subject matter as described above except wherein printing on the surface by the printing means is performed based in part on print information provided within the indicia; and wherein the hybrid printing device has a computer mouse form-factor.

However, Yamada '872 teaches wherein the hybrid printing device has a computer mouse form-factor (Fig. 2 and column 3, lines 45-46).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made wherein the hybrid printing device has a computer mouse form-factor as taught by Yamada '872 in the system of Desormeaux '124. A solution to the minimum size requirement of a conventional stand-alone printer and the limited types of print media that can be used to print an image is a hand-held printer that can be manually manipulated over a print medium (column 1, lines 44-48).

Desormeaux '124 and Yamada '872 discloses all the subject matter as described above except wherein printing on the surface by the printing means is performed based in part on print information provided within the indicia;

However, Rhoads '116 teaches wherein printing on the surface by the printing means is performed based in part on print information provided within the indicia (paragraph [0025], where the indicia contains print information embedded within to indicate the printer how to perform the printing);

Having a system of Desormeaux '124 and Yamada '872 and then given the well-established teaching of Rhoads '116 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hybrid printing device for printing on a surface of Desormeaux '124 and Yamada '872 to include printing on the surface by the printing means is performed based in part on print information provided within the indicia as taught by Rhoads '116 because it would allow the hybrid printing device to detect the instructions to be used to print on the paper.

4.   Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Desormeaux (US 6,312,124) in view of Rhoads et al. (US 2002/0176116).

Desormeaux '124 further discloses a method of printing on a surface (column 2, lines 66-67 and column 3, lines 1-8);

detecting the absolute position of a printing means housed within the handheld hybrid printing device in relation to the surface by detection of portions of the indicia pattern situated directly beneath the handheld hybrid printing device, and activating the printing means at designated locations on the surface as a function of the detected

position on that surface, to thereby print the actual printing pattern on the surface (column 7, lines 4-23, where the device can contain an optical sensor which detects indicia on a surface and responds to this indicia as to what operation to perform).

Desormeaux '124 discloses all the subject matter as described above except printing, with a handheld hybrid printing device, an indicia pattern on the surface prior to printing an actual printing pattern on the surface with the handheld hybrid printing device;

However, Rhoads '116 teaches printing, with a handheld hybrid printing device, an indicia pattern on the surface prior to printing an actual printing pattern on the surface with the handheld hybrid printing device (paragraph [0022]-[0023], where the watermark is being printed into a paper before printing the actual job).

Having a system of Desormeaux '124 and then given the well-established teaching of Rhoads '116 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hybrid printing device for printing on a surface of Desormeaux '124 to include an indicia pattern on the surface prior to print as taught by Rhoads '116 because it would allow the hybrid printing device to detect the instructions to be used to print on the paper.

5.   Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Desormeaux (US 6,312,124) and Rhoads et al. (US 2002/0176116) as applied to claims above, and further in view of Ichimura (US 5,878,200).

Desormeaux '124 and Rhoads '116 disclose all the subject matter as described above except wherein a printing control means remembers at which locations on the

surface have already been printed on, thereby allowing the movement of the hybrid device over the surface to be interrupted.

However, Ichimura '200 teaches wherein a printing control means remembers at which locations on the surface have already been printed on, thereby allowing the movement of the hybrid device over the surface to be interrupted (column 5, lines 18-31, where the print control code makes sure the printed portion is skip from further printing thereon).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have a printing control means remembers at which locations on the surface have already been printed on, thereby allowing the movement of the hybrid device over the surface to be interrupted as taught by Ichimura '200, in the system of Desormeaux '124 and Rhoads '116. With this the system makes sure that the printing device does not re-print or print something over a surface that has been printed thereon before.

6.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Desormeaux (US 6,312,124), Yamada (US 5,927,872) and Rhoads et al. (US 2002/0176116) as applied to claims above, and further in view of Zerza et al. (US 2004/0066525).

Desormeaux '124, Yamada '872 and Rhoads '116 disclose all the subject matter as described above except wherein the print information includes information as to which colors to print at a region corresponding to each respective indicia.

However, Zerza '525 teaches wherein the print information includes information as to which colors to print at a region corresponding to each respective indicia (paragraph [0032], where the indicia can contains information about colors to be printed on a surface).

Having a system of Desormeaux '124, Yamada '872 and Rhoads '116 and then given the well-established teaching of Zerza '525 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hybrid printing device for printing on a surface of Desormeaux '124, Yamada '872 and Rhoads '116 to include information as to which colors to print at a region corresponding to each respective indicia as taught by Zerza '525 because it would allow the hybrid printing device to detect the instructions to be used to print on the paper.

7.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Desormeaux (US 6,312,124) and Rhoads et al. (US 2002/0176116) as applied to claims above, and further in view of Zerza et al. (US 2004/0066525).

Desormeaux '124 discloses all the subject matter as described above except detecting print information provided within the indicia pattern, wherein the print information includes information as to which colors to print at a region corresponding to each respective indicia.

However, Rhoads '116 teaches detecting print information provided within the indicia pattern (paragraph [0025], where the indicia contains print information embedded within to indicate the printer how to perform the printing),

Having a system of Desormeaux '124 and then given the well-established teaching of Rhoads '116 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hybrid printing device for printing on a surface of Desormeaux '124 to include printing on the surface by the printing means is performed based in part on print information provided within the indicia as taught by Rhoads '116 because it would allow the hybrid printing device to detect the instructions to be used to print on the paper.

Desormeaux '124 and Rhoads '116 wherein the print information includes information as to which colors to print at a region corresponding to each respective indicia.

However, Zerza '525 teaches wherein the print information includes information as to which colors to print at a region corresponding to each respective indicia (paragraph [0032], where the indicia can contains information about colors to be printed on a surface).

Having a system of Desormeaux '124, Yamada '872 and Rhoads '116 and then given the well-established teaching of Zerza '525 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the hybrid printing device for printing on a surface of Desormeaux '124, Yamada '872 and Rhoads '116 to include information as to which colors to print at a region corresponding to each respective indicia as taught by Zerza '525 because it would allow the hybrid printing device to detect the instructions to be used to print on the paper.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LENNIN R. RODRIGUEZ whose telephone number is (571)270-1678. The examiner can normally be reached on Monday - Thursday 7:30am - 6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, King Poon can be reached on (571) 272-7440. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Supervisory Patent Examiner, Art Unit 2625

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Examiner, Art Unit 2625